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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,679	06/22/2000	Robert J. Brockway	TER003RA	7502

7590 06/05/2002
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St. Paul, MN 55128

EXAMINER

STORMER, RUSSELL D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/599,679

Applicant(s)
R. J. Brockway

Examiner
Russell D. Stormer

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3617



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 Apr 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) 26 and 27 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 is/are allowed.
- 6) ☒ Claim(s) 21-25 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Reissue Applications

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, **must** be received before this reissue application can be allowed. See 37 CFR 1.178.

Election/Restriction

2. Newly submitted claims 26 and 27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 26 sets forth the limitation of "mounting" a plurality of compaction cleats on the rim. This limitation is not found in the apparatus claims and infers that the cleats are separate members attached to the rim. Claim 21, for instance, makes no distinction as to whether the cleats are integral with the rim or mounted thereto. The mounting of the cleats to the rim is a method step and not part of the originally filed claims.

Claim 27 sets forth the limitation of removing a row of cleats, a method step which is clearly not defined in any of the originally filed claims.

The method of making the compactor wheel as set forth in claims 26 and 27 comprises method steps which were not set forth in the originally filed claims 1-23. A search for the method of constructing a wheel would require an additional search in at least class 29, which was not

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required in examination of the originally filed claims. And therefore would present an extreme burden on the Examiner.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26 and 27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Reissue Oath

It is noted that the statements made in paragraphs 6, 8, and 9 (note that there are two paragraphs labelled "6") of the Reissue Oath filed September 21, 2000, are considered to be incorrect and appear to introduce new matter into the file history because the disclosure of the parent application does not disclose or even suggest that the width of cleat-free area of the rim can be measured against anything other than the cleats 28 which are secured to the wheel rim.

The specification of the originally filed parent applicant makes it clear that the cleat-free area is obtained by removing the inner-most row of cleats 36, or by locating this row farther outward and extending the rim inward. See the last twelve lines of page 10 and all of page 11 of the specification of parent application 08/732901 and/or lines 13-60 of column 6 of the parent patent 5,769,507. Nowhere in the originally filed specification of the parent application is there any suggestion that the cleat-free area can be have at least the width of "any compaction cleat, not

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just the width of the compaction cleats mounted to the face of the rim” as stated in paragraphs 6 and 8 of the reissue oath.

The statements of paragraphs 6, 8, and 9 appear to introduce new matter into the file history because these statements define the width of the cleat-free area in terms broader than previously used to define the cleat-free area.

Applicant argues that originally field specification (in the Summary of the Invention) sets forth that there are a “number of ways” of preventing refuse from wrapping around the axle of a compaction machine. This is true, but none of the “number of ways” are set forth, and the specification is silent on how there^{5/} other ways could be employed.

Specification

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

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© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 as failing to adequately teach how to make and/or use the invention, i.e., failing to provide an enabling disclosure.

There is no description in the originally filed disclosure as to how wide the cleat-free area must be to be “wide enough that refuse is less likely to be directed toward the axle” of the compaction machine. There is no description of how wide is “wide enough” as set forth in claims 21, 23, and 25. Therefore, one of ordinary skill in the art would not be enabled to make and use the invention

Claim Rejections - 35 USC § 112

4. Claims 21-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no description in the specification to allow one of ordinary skill in the art to ascertain how wide is “wide enough that refuse is less likely to be directed toward the axle.”

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Finley and O'Neill et al.

Finley and O'Neill et al each teach a compaction wheel comprising a rim and a hub and a plurality of compaction cleats mounted to the face of the rim. A cleat-free area is provided on the rim adjacent the inner edge of the rim. While the references do not specifically state the cleat-free area would make it less likely that refuse would be directed toward the axle, this would have been obvious inasmuch as if the area is cleat-free, then it would be less likely that refuse would be able to adhere to the cleat-free area of the rim and then ~~would~~ be directed toward the axle.

With respect to claims 23 and 25, it is inherent that the wheels would be mounted to compaction machines.

With respect to claim 28, the width the cleat-free area extends across the rim is considered to be preselected.

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Interference

7. Claim 28 of this application has been presented as a proposed count claim. This claim is not patentable to the applicant because it has been rejected under 35 USC 103 as set forth in paragraph 7 above.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

8. It should be noted that claim 28 does not set forth the same patentable invention as is claimed in the 5,687,799 patent because claim 1 of the patent limits the (axially) outermost row of teeth (cleats) to be positioned immediately adjacent the outer periphery of the drum. While this is thought to mean that the axially outermost cleats are immediately adjacent the *edge* of the rim, this limitation is not found in the proposed count claim 28, and therefore the count claim is of a different scope than the patented claim. As noted in MPEP 2306, applicant must claim the same patentable invention as is claimed in the patent. Accordingly, an interference cannot be based on claim 28.

Allowable Subject Matter

9. Claims 1-20 are allowable over the prior art of record.

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Response to Arguments

10. Applicant's arguments filed April 23, 2002 have been fully considered but they are not persuasive.

With respect to the restriction, Applicant's argument that the restriction requirement is improper because of the similarities of the claims 21 and 26 is not a valid argument. The method claims 26 and 27 set forth limitations not found in claim 21.

With respect to the reissue oath, the emphasis on statements found in the specification such as "a number of ways" and "can be formed, for example" are noted, but the originally filed specification is absolutely silent on the cleat-free area being measured against "any" compaction cleat.

With respect to the specification, a "matter of simple trial and error experimentation" to determine the suitable width of the cleat-free area as argued is not proper support in the specification. The specification is silent on what is "wide enough."

With respect to the rejection under 35 USC 103(a), both the Finley and the O'Neill patents show compaction wheels with a cleat-free area.

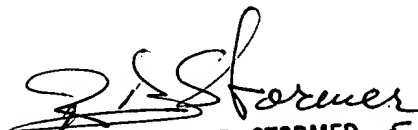
With respect to the question of interference, Applicant's opinions on the significance of the outermost row of cleats on the wheel of the '799 patent are given no weight. Applicant has not copied a claim from the '799 patent. The proposed count claim 28 has not been found to be allowable.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-1113.

rds

May 30, 2002


RUSSELL D. STORMER
PRIMARY EXAMINER 5/30/02